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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,045	12/27/2001	Thomas E. Jacobs	023720-0250	1658

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EXAMINER

BAHTA, ABRAHAM

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

CA

Office Action Summary	Application No. 10/034,045	Applicant(s) JACOBS, THOMAS E.	
	Examiner Abraham Bahta	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 35-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's election of Group I (claims 1-34) in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

The IDS filed 12/27/01 has been considered and initialed; however, the Serial No. 09/553,362 listed on the IDS has not been considered because it is not a published document

Claim Rejections - 35 USC § 112

Claims 4, 10, 11, 13, 23 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, it is not clear what is meant by a "foot print".

In claim 10 and 23, the phrase "configured to be attached" renders the claim indefinite because the claim does not recite how the article is configured to be attached to a support structure. If the article is attached to a support structure the claim should be drafted as such.

In claim 11, the phrase "configured to receive a fastening member" is not clear because the claim does not recite how the base of the article is configured to receive a fastening member.

In claim 13 and 27 it is not clear what is meant by "one characteristic is material"?

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. Claims 1, 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Houten

USP 6,517,168).

Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

Regarding claim 10, the wheel cover is configured to be attached to a wheel of a vehicle. See col. 4-7.

Regarding claim 11, the reference teaches the wheel cover may be mechanically fastened to a wheel. See col. 5, lines 8-10.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Houten

‘168.

As discussed above, Van Houten teaches applicant's claimed invention except the specific profiles, color and foot print, indicia, associated with the inserts as cited in claims 2-9; however, since Van Houten's teaches the decorative inserts may be replaceable or interchangeable, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the interchangeable inserts of Van Houten with various designs, shapes, colors and profiles in order to decorate or accent a vehicle according to the users individual taste.

Regarding claim 12, the reference does not require the cover to be fastened to a vehicle grille; however, it would have been obvious to one of ordinary skill in the art to modify the cover of Van Houten, for example, by changing the size of the cover and attach it to a desired support including a vehicle grille so that the device may be displayed in front of the vehicle.

Concerning claim 15, the reference does not mention the device is a medallion; however, a medallion is a flat piece of metal stamped with a design or inscription, therefore the wheel cover

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of Van Houten may be interpreted as a medallion because the device comprises depressions or pockets having various geometries and ornamental designs.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 23, 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Houten

'168.

Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

Regarding claim 23, the wheel cover is configured to be attached to a wheel of a vehicle. See col. 4-7.

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Regarding claim 25, the reference teaches depressions may be provided to the wheel cover. See col. 5, lines 17-20.

Claim Rejections - 35 USC § 103

Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Houten '168.

As discussed above, Van Houten teaches applicant's claimed invention except the specific profiles, color and foot print, indicia, associated with the inserts as cited in claims 16-22; however, since Van Houten's teaches the decorative inserts may be replaceable or interchangeable, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the interchangeable inserts of Van Houten with various designs, shapes, colors and profiles in order to decorate or accent a vehicle according to the users individual taste.

Regarding claim 24, the reference does not require the cover to be fastened to a vehicle grille; however, it would have been obvious to one of ordinary skill in the art to modify the cover of Van Houten, for example, by changing the size of the cover and attach it to a desired support including a vehicle grille so that the device may be displayed in front of the vehicle.

Concerning claim 26, the reference does not mention the device is a medallion; however, a medallion is a flat piece of metal stamped with a design or inscription, therefore the wheel cover

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of Van Houten may be interpreted as a medallion because the device comprises depressions or pockets having various geometries and ornamental designs.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-29, 31-32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by

Van Houten '168.

Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the reset of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

Regarding claim 29, the reference teaches the wheel cover comprises a set of interchangeable inserts.

The Examiner notes claims 28-34 are drawn to a product-by-process limitation; however, patentability of product-by-process claims are based on the product itself even though such claims

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are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Claim Rejections - 35 USC § 103

Claims 30, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Houten '168.

As discussed above, Van Houten teaches applicant's claimed invention except the surface profile which includes at least one of flat, concave and convex and color characteristic of a set of inserts; however, since the reference teaches various design decorations may be provided to the inserts, it would have been obvious to one of ordinary skill in the art to profile the inserts with various decorative shapes or designs as an obvious matter of design choice.

Claim Rejections - 35 USC § 103

Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockwood (USP 4,556,588) or Pierce (USP 6,434,873) in view of Van Houten '168.

Rockwood teaches an emblem made of two parts, a base and a capped inlay. The inlay is attached to the base member with a layer of an adhesive which is coated on the reverse side of foil member and which is the same as or similar to the adhesive layer. The reference teaches a rim may be provided around the base and the inlay may be sapped into place in the base member.

See col. 3, lines 1-11.

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Pierce teaches a decorative display comprising a cavity wherein the an insert is placed into the space defined by the cavity. The insert may be an embossed paper, embossed cardboard, embossed plastic, stamped metal sheet, a hologram and combinations thereof.

Thus, Rockwood and Pierce teach an emblem or a decorative display wherein an decorative insert may be placed in the space defined by cavity.

Rockwood or Pierce do not require a plurality of inserts having different characteristics; however, Van Houten teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover, so as to provide a variety of decorative contrasts between the turbine pockets and the rest of the vehicle wheel cover. An array of apertures, vents, or turbine pockets are disposed about the wheel cover. The turbine pockets are openings that extend through the wheel cover or alternatively can be closed depressions in one of the inboard or outboard surfaces of the wheel cover and the turbine pockets may take on any number of various geometries so that many different ornamental designs can be provided. See col. 5, lines 15-22.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the emblem of Rockwood or the display device of Pierce by providing more cavities or depressions and placing the desired number of interchangeable decorative inserts in the cavities or depressions as taught by Van Houten to provide, for example, a vehicle to which the emblem or decorative display may be attached in order to give unique or the desired look and/or visual effect.

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Regarding claims 2-9 , 16-22 and 29-34, since Van Houten inserts are decorative and interchangeable, it would be obvious to one of ordinary skill in the art to provide the desired color, outline, surface profile or indicia as a matter of obvious design choice.

Regarding claim 10 and 23, Rockwood teaches the emblem may be attached to a vehicle.

With respect to claim 11, Rockwood teaches the base member may have molded therewith tabs or projection which extend from the attachment surface for press-fitting into corresponding notches or holes on curved surface. See col. 2, lines 59-68.

With respect to claim 12 and 24, the references do require to attachment to a vehicle grille; however, since Rockwood teaches the emblem may be used to customize an automobile, it would be within the judgment of the skilled artisan to provide a suitable fastening means so that the emblem may fastened to a vehicle grille.

Concerning claim 14 and 26, Rockwood teaches the article is an emblem.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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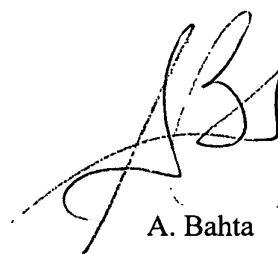
Any inquiry concerning this communication should be directed to Abraham Bahta at telephone number (703) 308-4412.

The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah, Jones, can be reached on (703) 308-3822.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


DEBORAH JONES
SUPERVISORY PATENT EXAMINER


A. Bahta

04/29/03